FILED
JUL 21 2003
OFFICE OF THE CLERK

No. 02-1833

IN THE

Supreme Court of the United States

ALAN JARDINE, an individual,

Petitioner,

v.

BROTHER RECORDS, INC.,

Respondent.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE NINTH CIRCUIT

BRIEF IN OPPOSITION

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QUESTIONS PRESENTED

Petitioner Alan Jardine's framing of the "question presented" by his Petition for Writ of Certiorari is both inaccurate and argumentative, since it presupposes that Jardine "properly asserted classic fair use and nominative fair use affirmative defenses." The Ninth Circuit Court of Appeals ruled that Jardine *failed* to establish a genuine issue of material fact on his fair use defense and therefore affirmed summary judgment in favor of respondent Brother Records, Inc., the owner of the trademark, *The Beach Boys*. Thus, more accurately phrased, the narrow question presented is rather:

> "Did the Ninth Circuit Court of Appeals err in affirming the district court's grant of summary judgment on petitioner Jardine's fair use affirmative defense."

STATEMENT PURSUANT TO RULE 29.6

Respondent, Brother Records, Inc., has no parent corporation and no publicly held company owns 10% or more of its stock.

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Sup. Ct. R. 10(a) 1

INTRODUCTION AND SUMMARY OF OPPOSITION TO THE PETITION FOR WRIT OF CERTIORARI

In his Petition, Jardine challenges the Ninth Circuit's application of correctly stated trademark law on fair use to the undisputed facts found by the district court to affirm summary judgment on Jardine's fair use defense. As shown in the Ninth Circuit's opinion, *Brother Records, Inc. v. Jardine*, 318 F.3d 900 (9th Cir. 2003) ("*BRI*"), Jardine did not contest any factual findings, nor did he contend that any genuine issue of fact precluded affirmance. That alone mandates that this Court deny the petition for a simple reason: the Ninth Circuit (and the district court) found on the undisputed facts in the extensive factual record – and unchallenged by Jardine – that BRI had established *actual* confusion caused by Jardine's use of "Beach Boy" in the various iterations of his musical group. *BRI*, 318 F.3d at 907 n.4. Actual confusion precludes a "fair use" defense, whether nominative or "classic." *Id.*

Thus, Jardine has failed to point to any reason (compelling or otherwise) that would justify granting certiorari, except, apparently, that this case involves *The Beach Boys*. For example, he does not contend that there is a conflict among the circuits that this Court should settle, or that the Ninth Circuit "has so far departed from the accepted and usual course of judicial proceedings, or has sanctioned such a departure by a lower court, as to call for an exercise of this Court's supervisory power." *See* Supreme Court Rule 10(a). As the very rules of this Court admonish petitioners, "a petition for a writ of certiorari is rarely granted when the asserted error consists of . . . the misapplication of a properly stated rule of law." Rule 10. Accordingly, the petition should be denied.

STATEMENT OF THE CASE

Because Jardine's statement of the case is either inaccurate or simply ignores the factual findings made by the district court and the Ninth Circuit, BRI suggests that this Court examine the District Court's extensive opinion (attached to Jardine's Petition for Writ of Certiorari at 23a-32a), seconded by the Ninth Circuit (2a-5a), as to the facts found to be undisputed in this case. Instead of repeating the facts from those opinions, BRI will limit itself to pointing out the misstatements in Jardine's Petition.

First, nowhere in the record is there support for Jardine's statement that he toured as "Beach Boy Al Jardine and *his* Family & Friends." Instead, as the District Court found, it was undisputed by Jardine that both "Beach Boys Family & Friends," "Beach Boy Al Jardine and Family & Friends" and various potential derivations, caused actual confusion in the market. (Petition, 32a). Not only did the district court find that there was undisputed evidence of actual confusion with the consuming public, but the district court also found it undisputed that the names caused actual confusion among the more sophisticated producers of musical events. *Id.*

As the Ninth Circuit elaborated on this same point from its *de novo* review of the record before the district court,

> Jardine and his band performed in locations and on dates close to Love's "The Beach Boys" shows. With two bands touring as The Beach Boys or as a similar-sounding combination, show organizers sometimes were confused about what exactly they were getting when they booked Jardine's band. A number of show organizers booked Jardine's

> band thinking they would get The Beach Boys along with special added guests, but subsequently canceled the booking when they discovered that Jardine's band was not what they thought it was. Numerous people who attended one of Jardine's shows said that they had been confused about who was performing.

BRI, 318 F.3d at 902-903 (Petition, 4a-5a).

Although seemingly not germane to the petition, Jardine also again claims that BRI's decision to grant fellow Beach Boy Mike Love a non-exclusive license to tour as *The Beach Boys* as a breach of Jardine's "contractual right under Jardine's *The Beach Boys* Employment Agreement" to perform as *The Beach Boys*. (Petition, p. 4). Both the Ninth Circuit and the district court ruled as a matter of law that there was no such employment agreement. Jardine also contends that he voted against approving BRI's license to Mr. Love, when the district court and the Ninth Circuit found that "Jardine voted for this resolution." (Petition, p. 3a, 29a).

Finally, Jardine contends that BRI "immediately interfered with Jardine's efforts to tour as *The Beach Boys* pursuant to the non-exclusive license." (Petition, p. 5). Both the District Court and the Ninth Circuit found on undisputed facts that Jardine *rejected* the terms of the non-exclusive license and toured as "Beach Boys Family & Friends" notwithstanding his rejection of the license. (Petition, p. 4a, 29a). Moreover, the courts below found as undisputed facts that Jardine continued to tour despite repeated "cease and desist" letters from BRI concerning his actual and proposed band names and therefore suffered no damages.

REASONS FOR DENYING THE PETITION

A. Likelihood of Confusion Precludes Any "Fair Use" Defense.

Under § 32 of the Lanham Act, the owner of a trademark is protected from unauthorized uses that are "likely to cause confusion, or to cause mistake, or to deceive." *San Francisco Arts & Athletics, Inc. v. United States Olympic Committee*, 483 U.S. 522, 531, 107 S. Ct. 2971, 97 L. Ed. 2d 427 (1987), citing 15 U.S.C. § 1114(1)(a). Undisputed evidence of actual confusion precludes *any* fair use defense, whether so-called "classic" or "nominative." As the Ninth Circuit recently held and which is undisputed by Jardine in his Petition as a correct statement of the law,

> "Still, the 'core element' of trademark infringement law is 'whether an alleged trademark infringer's use of a mark creates a likelihood that the consuming public will be confused as to who makes the product.' " [citation omitted] Accordingly, this court has held that "the nominative fair use defense is available only if 'the use of the trademark does not attempt to capitalize on consumer confusion or to appropriate the cachet of one product for a different one.' " [citation omitted].

Horphag Research, Ltd. v. Pellegrini, 328 F.3d 1108, 1112 (9th Cir. 2003) (nominative fair use defense unavailable if use causes actual confusion). Concerning "classic" fair use, the Ninth Circuit correctly stated that "the classic fair use defense is not available if there is a likelihood of customer confusion as to the origin of the product." *BRI*, 318 F.3d at

907 n.4. Thus, the Ninth Circuit's statement in footnote 4 is dispositive of this Petition and the case:

> We note that the district court found, as an undisputed fact, that Jardine's use of the trademark "caused numerous instances of confusion both with the consuming general public and with the producers of musical events." On appeal, Jardine does not challenge the district court's conclusion that his use of the trademark caused confusion.

Id.

The core of the Petition is that "Beach Boy Al Jardine and Family & Friends" is a "fair use" of *BRI's* trademark and therefore not trademark infringement. Conspicuously absent from Jardine's legal argument is any discussion of the Ninth Circuit's finding of actual confusion stemming from Jardine's unauthorized use of BRI's trademark, whether the name is "Al Jardine of the Beach Boys and Family & Friends; The Beach Boys "Family and Friends"; Beach Boys Family & Friends; The Beach Boys, Family & Friends; Beach Boys and Family;" etc., *i.e.*, the various iterations Jardine used.[1] That undisputed finding precludes a fair use defense and Jardine's Petition must be denied.

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1. The sum total of Jardine's discussion on that point is merely that "Jardine's fair use defense nullifies BRI's confusion argument." Petition, p. 10. Far from being an "argument," as set forth above, the Ninth Circuit found that actual confusion was undisputed. Tangentially, Jardine also contends that a fair use defense obviates an examination of the "likelihood of confusion" test under the Lanham Act, *id.*, a claim simply contrary to law.

B. The District Court's Permanent Injunction Is Subject To An "Abuse Of Discretion" Standard Of Review Which Again Supports Denial of Certiorari.

Rendered to its essentials, Jardine seeks to challenge the scope of the district court's permanent injunction, contending that "Beach Boy Al Jardine" should not be included in the injunction. However, the district court's grant of permanent injunctive relief is reviewed for an abuse of discretion or application of erroneous legal principles. *Image Tech. Servs. v. Eastman Kodak Co.*, 125 F.3d 1195, 1224 (9th Cir. 1997) *citing Dexter v. Kirschner*, 984 F.2d 979, 982 (9th Cir. 1992). This Court has repeatedly recognized that "the framing of decrees should take place in the District rather than in Appellate Courts" and has generally followed the principle that district courts "are invested with large discretion to model their judgments to fit the exigencies of the particular case." *United States v. Glaxo Group Ltd.*, 410 U.S. 52, 64, 35 L. Ed. 2d 104, 93 S. Ct. 861 (1973). Given the factual findings by the district court that the very uses proposed (and actually used by Jardine have caused actual confusion among consumers and even more sophisticated music producers, it cannot be said that the district court abused its discretion in fashioning a permanent injunction).

CONCLUSION

For the foregoing reasons set forth herein, Jardine's petition for writ of certiorari should be denied.

Respectfully submitted,

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